Remarks

Claims 21 and 22 are amended herein, and previously withdrawn claims 12 - 20 are canceled. No new matter is introduced by any of the amendments, and entry thereof is requested.

Claims 1 - 11, 21 and 22 are now in the application. Reconsideration of the application, as amended, is requested.

The points raised in the Office action will now be addressed, beginning with the objections to the claims.

Claim Objections

Claims 21 and 22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner asserted that these claims "both recite the same structure of the multi-package module."

Each of claims 21 and 22 is amended herein to recite that the multi-package module is interconnected to underlying circuitry. Support for this recitation is found at many places throughout the specification. Each of these claims as amended further limits the subject matter of claim 1, from which reach of these claims depends, and these objections can now be withdrawn.

Double Patenting Rejection

Claims 1 - 11, 21 and 22 were rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,906,416. The Examiner stated:

> Although the claims are not identical, they are not patentably distinct from each other because instant application and the patent both recite an inverted second package (i.e. upper package) stacked on a first package (i.e. lower package).

This is not well understood. The Examiner has not articulated how Applicant's invention as claimed would have been obvious over claim 1 of the reference patent (U.S. 6,906,416). It is not enough to state, as the Examiner has here, what may be recited in both the application claims and the patent claim. An obviousness analysis must follow, identifying the differences between the claims of the application and the claims of the reference patent, and stating reasons why those

differences would have been obvious to the person of ordinary skill in the art. Because no obviousness analysis has been made here, Applicant cannot agree with the Examiner's double patenting rejection of the claims of the Application over claim 1 of the reference patent.

Applicant submits herewith a Terminal Disclaimer and a fee therefor, and accordingly this Double Patenting rejection should be withdrawn.

The Examiner's attention is directed to U.S. Patent No. 6,933,598, which issued August 23, 2005 from commonly-owned U.S. Application No. 10/681,833, which was filed on the same date this Application was filed (October 8,2003).

Provisional Double Patenting rejections

Where no patent has yet issued and no claim has yet been allowed in a reference application, there would appear to be no predicate upon which Applicant can make a reasonable response to a Provisional Double Patenting Rejection. For example, Applicant cannot reasonably make a Terminal Disclaimer with respect to a reference application from which it is not yet known whether any patent will be granted. And, for example, when prosecution of the claims is not yet complete in a reference application, it is not possible to know whether the claims in the instant application claim the same invention as (for a statutory type double patenting rejection), or are patentably distinct from, claims in any patent that may issue from the reference application and, accordingly, Applicant cannot yet know whether, or how, any claim amendment should be made in the instant application.

In such circumstances, the Applicant may traverse the rejection on the grounds that it is not at this time possible to know what claims may eventually issue in the reference application and, accordingly, it is not possible to know whether the claims in the instant application will be patentably distinct, with or without amendment, from claims in any patent that may be granted on the reference application. Applicant responds accordingly, below.

Provisional Nonstatutory Double Patenting Rejections

Claims 1 - 11, 21 and 22 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting: over claim 1 of copending Application No. 10/681,734; or over claim 1 of copending Application No. 10/681,735; or over claim 1 of copending Application No. 10/681,532; or over claim 1 of copending Application No. 10/681,583 (the "Reference Applications"). (All these applications were filed on the same date, and are commonly owned.)

To the extent a reply may be required at this point in prosecution, these rejections are traversed, on the grounds following.

As the prior Office action noted, these are provisional double patenting rejections because the claims that are alleged to be conflicting have not in fact been patented. Moreover, prosecution is not yet complete in any of the Reference Applications. Particularly:

> No substantive action has yet been made in Application No. 10/681,583 (a Restriction Requirement was mailed September 22, 2005).
>
> Claim 1 in each of Application No. 10/681,735 and Application No. 10/681,572 stands rejected under 35 U.S.C. § 103 and/or § 102, and it is unknown to Applicant at this time whether (or to what extent) Applicants' responses to these rejections may be successful.

As to Application No. 10/681,734: only Double Patenting and Provisional Double Patenting rejections stood in an Office action mailed July 29, 2005 in that application. In response to that Office action, Applicant filed a terminal Disclaimer to remove the Double Patenting rejection, and pointed out that, inasmuch as only provisional double patenting rejections remained in that application, that Application was in condition for allowance. Upon issuance of a patent from Application No. 10/681,734 (*see*, discussion of MPEP 804.I.B, *infra*) the provisional double patenting rejections in this application should be converted to double patenting rejections, and Applicant will at that time be able to make a response to those rejections in this application.

Thus, it is not at this time possible to know what claims may eventually issue in any of the Reference Applications and, accordingly, it is not possible to know whether the claims in the

instant application will claim the same invention, or will be patentably distinct, with or without amendment, from claims in any patent that may be granted on any of the Reference Applications.

As the MPEP notes,

> Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications ..., the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

(MPEP 804.I.B.) Applicant appreciates the Examiner's attention in having made the Applicant aware of what appeared to the Examiner to be a potential double patenting problem in the instant application. In the instant application, however, for the reasons noted above, it is not possible for the Applicant to resolve the issue at this time. Applicant expects that the provisional double patenting rejections will be maintained as long as there are conflicting claims in more than one application, until prosecution has proceeded to the point that the double patenting rejection is the only rejection remaining in one of the applications.

> The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications.

(MPEP 804.I.B.) Then:

> If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

(MPEP 804.I.B.) This orderly process will allow the Applicant at an appropriate time to determine an appropriate response (traversal; or claim amendment; or, for the obviousness-type double patenting rejections, terminal disclaimer) to any double patenting rejection (fully matured, not "provisional") that may have been maintained in an application following issuance of a patent in another application that is alleged to have conflicting claims.

In this Application, a Terminal Disclaimer has disposed of the Obviousness-Type Double Patenting rejection over U.S. 6,906,416, and the provisional double patenting rejections are now the only rejections remaining in this Application. In these circumstances, the Examiner should withdraw the rejections in this Application and permit this Application to issue as a patent, thereby converting the "provisional" double patenting rejections in the Reference Application(s) into a double patenting rejection(s) once this Application issues as a patent. As the Examiner may appreciate, an early allowance of this Application should afford the Applicant sufficient information to enable the Applicant to act on the pending provisional double patenting rejections, by way of argument or amendment or Terminal Disclaimer, in the Reference Applications.

In view of the foregoing, all the claims now in the application, namely claims 1 - 11, 21 and 22, are believed to be in condition for allowance, and action to that effect is respectfully requested.

This paper is accompanied by a Terminal Disclaimer together with a fee therefor; and by a supplemental Information Disclosure Statement together with a fee therefor.

This Response is being filed within the three months' shortened statutory period set by the Examiner for response to the Office action and, accordingly, no fee is due. In the event the Examiner may determine that additional fee[s] may be required in connection with the filing of this paper, petition is hereby made therefor, and the Commissioner is authorized to charge any additional fee (or to credit any overpayment) to Deposit Account No. 50-0869 (CPAC 1029-7).

If the Examiner determines that a conference would facilitate prosecution of this application, the Examiner is invited to telephone Applicants' representative, undersigned, at the telephone number set out below.

Respectfully submitted,

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